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EXAMINER

ARYANPOUR, MITRA

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 05/28/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/920,173

**Applicant(s)**

LACY, JAMES K.

**Examiner**

Mitra Aryanpour

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 2-4 recite the limitation "an open glass bottle"; "a closed bottle"; and "the bottle" in lines 1 respectively. There is insufficient antecedent basis for this limitation in the claim. There is no antecedent basis since "the bottle" has not been positively recited, meaning it is not being claimed.

4. Claims 2-4 are indefinite, for not further limiting claim 1. Claim 1 does not need "the bottle" in order to function. Applicant's comments have been noted regarding claim 1, that "a bottle" is not being claimed, and since the aforementioned is not claimed therefore the claim is indefinite since it does not further limit claim 1.

5. Claim 7 recite the limitation "the ball" in line 4. There is insufficient antecedent basis for this limitation in the claim. There is no antecedent basis since "the has" has not been positively recited, meaning it is not being claimed.

6. Claim 7 is indefinite, for not further limiting claims 1. Claim 1 does not need "the ball" in order to function. Applicant's comments have been noted regarding claim 1, that "a ball" is not being claimed, and since the aforementioned is not claimed therefore the claim is indefinite since it does not further limit claim 1.

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7. Claim 15 recites the limitation "the ball" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 15 is indefinite, for not further limiting claims 7 or claim 1. Claims 7 and 1 do not need "the ball" in order to function. Applicant's comments have been noted regarding claims 7 and 1, that "a ball" is not being claimed, and since the aforementioned is not claimed therefore the claim is indefinite since it does not further limit claims 7 and 1.

9. Claims 24-26 recite the limitation "an open bottle"; "a closed bottle"; and "the bottle" in line 1 respectively. There is insufficient antecedent basis for this limitation in the claim.

10. Claims 24-26 are indefinite, for not further limiting claim 23. Claim 23 does not need "the bottle" in order to function. Applicant's comments have been noted regarding claim 23, that "a bottle" is not being claimed, and since the aforementioned are not claimed therefore the claim is indefinite since it does not further limit claim 23.

11. Claims 33-35 recites the limitation "an open bottle"; "a closed bottle"; and "the bottle" in line respectively. There is insufficient antecedent basis for this limitation in the claim.

12. Claims 33-35 are indefinite, for not further limiting claim 32. Claim 32 does not need "the bottle" in order to function. Applicant's comments have been noted regarding claim 32, that "a bottle" is not being claimed, and since the aforementioned is not claimed therefore the claim is indefinite since it does not further limit claim 32.

13. Claim 41 recites the limitation "the two rods" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ruderman (2,736,558).

Ruderman discloses a game that substantially mimics an aspect of a sport, the game comprising: a scoring structure (57) operable to accommodate a ball in a manner substantially mimicking a scoring aspect of the sport; and a mechanism for removably coupling (20) the scoring structure (57) with a bottle (21-25) to thereby position the scoring structure for playing.

*IN ADDITION:*

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879) in view of Zerpa (2,535,474).

Candor et al shows a game that substantially mimics an aspect of a sport, the game comprising: a scoring structure (22) operable to accommodate a ball (B) in a manner

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substantially mimicking a scoring aspect of the sport; and a mechanism (24) for removably coupling the scoring structure (22) with a bottle (21) to thereby position the scoring structure for playing. Candor et al as described above shows the support structure can be a plastic jug or a milk-type container. Zerpa shows a chance device having a hollow base (1), a simulation of a bottle (2), and a series of disc-like members (8) slidably positioned on a rod (6). Zerpa shows the support structure to be a bottle. Therefore, in view of the above references it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized different types of containers/bottles as support stands order to mimic different aspects of a game.

Regarding claim 2, Candor et al shows using any type of commercial or home use products such as milk, fruit juice, water, detergents bottles, etc. made of elastomeric material such as plastic, or any other suitable material as long as it is non-breakable (see column 4, lines 4-14). However, traditionally “jugs”, are containers that are made of glass, or metal having a small mouth, a handle, and usually a stopper or cap. It would have been obvious to use a glass container or jug if the material was readily available at the time of the invention.

Regarding claim 3, Candor et al shows the jug or container to be plastic.

Regarding claim 4, Candor et al shows the bottle is weighted with a weighted material to aid stability (see column 5, lines 40-50).

18. Claims 5-11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879) and Zerpa (2,535,474) in view of Williams (2,889,149).

Regarding claim 5, Candor et al as described above shows the game to substantially mimic baseball. Candor et al does not show the game device to be basketball, therefore there is

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no need for a shot ramp. However, Williams shows a miniature basketball game having a support stand (11), a basket (16), a backboard (17) and a deflector or shot ramp (18) operable in cooperation with a force applied to the ball, to launch the ball upward and toward the scoring structure (which is the basket 16). It would have been obvious and to have utilized the support structure of Candor et al, so that the support structure (21) can be used for a variety of sports, including the basketball game shown by Williams.

Regarding claim 6, Candor et al's game device is used in conjunction with a backstop having a net in order to limit the ball travel. This is a common feature in a baseball type setting.

Regarding claim 7, Candor et al as described above shows the support structure to be used for a baseball setting. Williams as described above shows a miniature basketball-type game, that has a backboard (17), a basket with a net (16), and a support stand (11) attached to a base (12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the support structure of Candor et al for sports other than baseball, so that the game device is more cost effective and the base support, more stable.

Regarding claims 8-11, Candor et al as modified above does not expressly disclose the use of cardboard drink coasters, or retaining clips. However, Candor et al does suggest the use of suitable material such as cardboard, rubber or other elastomeric materials such as thin walled plastic materials (see column 5, lines 23-27). Candor et al teaches the use of conventional mechanical expedients based on routine design considerations in order to reduce cost of manufacturing.

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Regarding claim 15, Candor et al as modified above does not expressly indicate if the ball is a ping pong ball. Ping pong balls are well known and it would have been obvious to use it for the modified game device of Candor et al, since it is resilient, small and readily available.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879) and Zerpa (2,535,474) and Williams (2,889,149), as applied to claim 7, and further in view of Hodges (4,025,074).

Regarding claim 12, Candor et al as modified in view of Williams does not show a circular shot ring operable to define an area wherein the ball must appear prior to entering the basket. Hodges shows a mini-dome basketball game having a basket (88), a backboard 57, and a circular shot ring (39) positioned on the floor area. It would have been obvious in view of Hodges to further include a circular marking for the modified game device of Candor et al, in order to create a more realistic game setting.

20. Claims 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879) and Zerpa (2,535,474) and Williams (2,889,149), as applied to claim 7, and further in view of Collins (4,202,543).

Regarding claim 13, Candor et al as modified in view of Williams, does not include a shot blocking device. Collins shows a recreational basketball game and facility having a support stand (40), a basket (90), a backboard (91) and a shot blocking device, wherein the shot blocking device comprises a handle (87) coupled with a paddle (86) and operable to block the ball from entering the basket (column 4, lines 59-68). It would have been obvious to also include a



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blocking arm for the modified device of Candor et al, in order to make the game device more challenging.

Regarding claim 14, Candor et al as modified in view of Williams, does not show the use of drinking straw, but teaches the use of rubber or other elastomeric materials such as thin walled plastic materials (see column 5, lines 23-27). A straw is considered to be a “thin walled plastic material”.

21. Claims 16, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879) and Zerpa (2,535,474) as applied to claim 1, and further in view of Kemp (6,070,879).

Regarding claim 16, Candor et al as disclosed above shows the support structure to be used for a baseball setting. Kemp shows a tabletop football goal and net having a goal post (16), left and right uprights (32, 30) and a crossbar (20). It would have been obvious in view of Kemp to one having ordinary skill in the art at the time the invention was made to have utilized the support structure of Candor et al for sports other than baseball, so that the game device is more cost effective and also to have a more stable base support.

Regarding claim 17, Candor et al as modified above does show the use of drinking straw for the uprights, but teaches the use of rubber or other elastomeric materials such as thin walled plastic materials (see column 5, lines 23-27). A straw is considered to be a “thin walled plastic material”.

Regarding claim 19, Candor et al as modified in view of Kemp does not expressly disclose the use of cardboard drink coasters, or retaining clips. However, Candor et al does

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suggest the use of suitable material such as cardboard, rubber or other elastomeric materials such as thin walled plastic materials (see column 5, lines 23-27). Candor et al teaches the use of conventional mechanical expedients based on routine design considerations in order to reduce cost of manufacturing.

22. Claims 18, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879), Zerpa (2,535,474) and Kemp (6,070,879) as applied to claim 16, and further in view of Nieland (3,675,922).

Regarding claim 18, Candor et al as modified in view of Kemp does not show the spacing between the uprights to be variable. Nieland shows a portable goalpost having a variable post (40), left and right uprights (21) and an extendable crossbar (10). It would have been obvious in view of Nieland to have provided a goal assembly that is readily assembled, and which took up minimum space when disassembled for the modified assembly of Candor et al.

Regarding claims 20 and 21, Candor et al as modified in view of Kemp further show a kicking tee (60) positioned on the playing surface and operable to support a ball (100') in a playing position (see column 3, lines 55-71).

23. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879), Zerpa (2,535,474) and Kemp (6,070,879) as applied to claim 16, and further in view of Klaus (1,661,292).

Regarding claim 22, Candor et al as modified in view of Kemp show the game further including a kicking device operable to transfer a force to the ball (upon placing the ball on the tee

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the player manually transfers force on the ball in order to make a shot). Nonetheless, for the sake of argument Klaus shows a toy ball-shot device having a vertical support (12), a scoring structure (13) and a ball ejector (15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a ball ejector such as the one described by Klaus for the modified game device of Candor et al so that the game becomes more challenging.

24. Claims 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879), Zerpa (2,535,474) in view of Williams (2,889,149), Hodges (4,025,074) and Collins (4,202,543).

Regarding claim 23, see comments for claims 1, 7, 9, 10, 12 and 13.

Regarding claim 24, see comments for claim 2.

Regarding claim 25, see comments for claim 3.

Regarding claim 26, see comments for claim 4.

Regarding claim 27, see comments for claim 8.

Regarding claim 28, see comments for claim 11.

Regarding claim 29, see comments for claim 14.

Regarding claim 30, see comments for claim 15.

Regarding claim 31, see comments for claim 5.

25. Claims 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879), Zerpa (2,535,474) in view of Kemp (6,070,879), Nieland (3,675,922), and Klaus (1,661,292).

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Regarding claim 32, see comments for claims 1, 16, 20 and 22.

Regarding claim 33, see comments for claim 2.

Regarding claim 34, see comments for claim 3.

Regarding claim 35, see comments for claim 4.

Regarding claim 36, see comments for claim 21.

Regarding claim 37, see comments for claim 17.

Regarding claim 38, see comments for claim 18.

Regarding claim 39, see comments for claim 19.

26. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candor et al (3,854,879), Zerpa (2,535,474), Kemp (6,070,879), Nieland (3,675,922), and Klaus (1,661,292), as applied to claim 32, and further in view of Franklin et al (D321,736).

Candor et al as modified in view of Kemp does not show a backstop having a net, and it also does not show the use of two bottles as support structures for the uprights. Franklin et al shows a tabletop football goal and net, wherein the net acts as a backstop. It would have been obvious in view of Franklin et al to have provided a net for the modified structure of Candor et al in order to prevent the balls from traveling substantially beyond the goal area.

Regarding claim 41, Candor et al as modified in view of Kemp only show one bottle used for supporting the left and right uprights. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided separate support structures for the modified device of Candor et al, since it has been held that mere duplication of the essential

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working parts of a device involves only routine skill in the art. St Regis paper Co. v. Bemis Co., 193 USPQ 8 (7<sup>th</sup> Cir. 1977).

***Response to Arguments***

27. Applicant's arguments filed March 7, 2003 have been fully considered but they are not persuasive. Acknowledgement is made of applicant's assertion that "the ball" and "the bottle" are not being claimed, therefore, all that is being claimed in the base claims 1, 23 and 32 is the scoring device that is capable of being used with a bottle or any other object for that matter and that is capable of receiving a ball or any other object, but neither limitation is a requirement.

28. In response to applicant's argument that the cited references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, since applicant is merely claiming a "scoring structure" the cited references would all be considered "analogous art" since that is what they show.

29. In response to applicant's arguments, the recitation *a game that substantially mimics an aspect of a sport (in claim 1) of basketball (in claim 23) and a sport of football (in claim 32)* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

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See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

30. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). The cited references relied upon have been used to demonstrate that features relied upon are old and conventional. Absent a showing of new or unobvious results, there is nothing unobvious about combining the cited references to show that certain material are known and commonly used in the sports art. E.g. the bottle (which incidentally is not claimed) is glass, plastic, hollow or solid and/or weighted; the ball (again which is not being claimed) being a ping pong ball; a cardboard being used for the backboard instead of say plywood; a straw used instead of a vertical support made of plastic tubing for the handle; and the scoring device utilized for sports or games such as basketball, football or baseball.

### ***Conclusion***

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700

MA  
May 22, 2003